

- b) at least one polyamide-compatible, oxidizable polydiene; and
- c) at least one oxidation promoting metal salt catalyst.

In its broadest aspect, the claims of U.S. patent 6,423,776 are directed to

1. A polyamide composition which comprises a **polyamide homopolymer, copolymer, or blends thereof**, at least one polyamide reactive, oxidizable polydiene or oxidizable polyether, and an oxidation promoting metal salt catalyst.

The examiner's position is that the claims are patentably distinct because the patent claims "blends" which generically embrace the presently claimed polyamide blend. It is submitted that this is not the correct standard for asserting an obviousness-type double patenting rejection.

Clearly each of the patent and this application concern a composition comprising polyamide blends, an oxidizable polydiene and an oxidation promoting metal salt catalyst. However, this is not determinative of obviousness-type double patenting.

Double patenting is concerned with attempts to **claim** related subject matter twice. It does not prohibit a later claiming of subject matter that is disclosed but not claimed in an earlier patent or application. Cf. *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971) (applicant may file an application claiming subject matter disclosed in his earlier patent). In considering the obvious variation question, the *disclosure of the patent or earlier application may not be used as prior art*.

Obviousness type double patenting rejections are analogous to obviousness rejections under 35 U.S.C. Section 103. *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29, 34 (CCPA 1967). The subject matter of the claim on which the rejection is based may be viewed as the "primary document." The entire disclosure of the patent is *not available* as a reference.

However, to support a double patenting rejection, the examiner must point out what *claim* in the commonly assigned application is to the same invention, not merely conclude the same invention is *claimed*. Ex parte Crissy et al., (POBA 1976) 201 USPQ 689. The only issue is whether the *claims* of the application are claiming applicant's patented invention in different language. In re Conix et al (CCPA 1969) 405 F2d 1315, 160 USPQ 420; In re Eckel (CCPA 1968) 393 F2d 848, 157 USPQ 415; In re Faust et al CCPA 1967) 378 F2d 966, 153 USPQ 813, (interpreting Hays v. Brenner (DC Cir 1966) 357 F2d 287, 148 USPQ 365).

Clearly when one views claims 1-18 of U.S. 6,423,776, a blend of polyamides is included, but such does not suggest a slow crystallizing polyamide blend comprising (i) an **amorphous**, semiaromatic polyamide homopolymer, copolymer or mixture thereof and (ii) a semicrystalline, aliphatic polyamide homopolymer, copolymer or mixture thereof wherein in the weight ratio of (i):(ii) ranges from about 99:1 to about 30:70;

Please note that there is no mention in the claims of an **amorphous**, semiaromatic polyamide, much less a blend of an **amorphous**, semiaromatic polyamide with a semicrystalline, aliphatic polyamide in the indicated weight ratio.

The examiner is apparently confusing double patenting with claim domination.

By domination we refer, in accordance with established patent law terminology, to that phenomenon, which grows out of the fact that patents have claims, whereunder one patent has a broad or "generic" claim which "reads on" an invention defined by a narrower or more specific claim in another patent, the former dominating the latter because the more narrowly claimed invention cannot be practiced without infringing the broader claim. To use the words of which the board seemed to be enamored, the broader claim "embraces" or "encompasses the subject matter defined by the narrower claim. In possibly simpler terms, one patent dominates another if a claim of a first patent reads on a device built or practiced according to the second disclosure. This commonplace situation is not, per se, double patenting as the board seemed to think. *In Re Kaplan* 229 USPQ 678 (CCPA 1986) citing *In re Sarett* 140 USPQ 474 (CCPA 1964).


As one can see, this is exactly the situation which we have here. Although the claims of U.S. 6,423,776 may generically "embrace", "encompass" or "dominate" the instant claims this is not an obviousness-type double patenting situation because the claims of this application are not obvious variants of claims 1-18 of U.S. 6,423,776. While the claims of U.S. 6,423,776 may suggest polyamide blends, this is not sufficient to obviate the instant claims because the claims of U.S. 6,423,776 clearly do not and cannot suggest the instantly required blend of an **amorphous**, semiaromatic polyamide with a semicrystalline, aliphatic polyamide in the indicated weight ratio. While the instant claims *require* a blend of an **amorphous**, semiaromatic polyamide with a semicrystalline, aliphatic polyamide in the indicated weight ratio, the claims of U.S. 6,423,776 do not even mention an **amorphous**, semiaromatic polyamide. For these reasons it is urged that the obviousness-type double patenting rejection should be withdrawn.

The undersigned respectfully requests re-examination of this application and believes it is now in condition for allowance. Such action is requested. If the examiner believes there is any matter which prevents allowance of the present application, it is requested that the undersigned be contacted to arrange for an interview which may expedite prosecution.

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I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office (FAX No. 703-872-9310) on October 7, 2003.


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